

REMARKS

By this Amendment, Applicant amends claims 1, 8, and 9 for clarity and to more appropriately define the present invention, cancels claims 3-7 and 11-14 without prejudice or disclaimer of the subject matter thereof, and adds new claims 15-18 to further define Applicant's invention. Claims 1, 8-10, and 15-18 are now pending in this application.

At the outset, Applicant respectfully requests the Examiner to provide in the next Office Action the status of a Petition to Withdraw Preliminary Amendment that was filed on July 25, 2001. To date, Applicant has not received a response regarding the status of the Petition.

In the Office Action mailed January 16, 2004, the Examiner rejected claims 1 and 3-14 under 35 U.S.C. § 103(a) as being unpatentable over Taivitie et al. (U.S. Patent No. 6,133,884) in view of Suga et al. (U.S. Patent No. 6,427,065). Applicant respectfully traverses the rejection, and notes that because Applicant has canceled claims 3-7 and 11-14, the rejection with regard to these claims is now moot.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must meet each of the following three requirements. First, the reference taken alone, or references combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th

ed. 2001). Moreover, each of these requirements must be found in the prior art, and not be based on applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Applicant's claim 1, as amended, recites an IC card for insertion into a card slot of a host device including, among other things, "a radio frequency circuit," and "a connector connected to the radio frequency circuit and attachable to and detachable from an antenna located outside the IC card, wherein the radio frequency circuit is detached from the antenna if the IC card is removed from the card slot." Taivitie and Suga, taken alone or in combination, do not disclose or suggest at least these features.

Taivitie discloses that PCMCIA card 50 includes antenna socket 51. One may install antenna module 40 in antenna socket 51 via antenna plug 43. By doing so, antenna module 40 becomes attached to PCMCIA card 50. However, Taivitie does not disclose "a radio frequency circuit." Instead, antenna module 40 includes a radiating antenna conductor 42 having a helix construction. See col. 5, lines 62-65.

Moreover, as disclosed by Taivitie in Fig. 5, antenna module 40 is separate from PCMCIA card 50 and becomes detached from PCMCIA card 50 when it is removed from antenna socket 51. By contrast, Applicant's claim 1, as amended, recites "a connector connected to the radio frequency circuit and attachable to and detachable from an antenna located outside the IC card, wherein the radio frequency circuit is detached from the antenna if the IC card is removed from the card slot." Taivitie therefore does not disclose all of the features of Applicant's claim 1.

Nor does Suga make up for the above-described shortcomings of Taivitie. Suga discloses a power transmission system, an IC card, and an information communication system using the IC card. See Abstract. The Examiner has applied Suga because he

alleged it discloses a controller configured to control access to the memory and to control the radio frequency circuit, a feature the Examiner admitted was not disclosed by Taivitie. See Office Action, page 2. However, Suga does not disclose or suggest at least an IC card for insertion into a card slot of a host device including at least "a connector connected to the radio frequency circuit and attachable to and detachable from an antenna located outside the IC card, wherein the radio frequency circuit is detached from the antenna if the IC card is removed from the card slot," as recited in claim 1, nor does the Examiner rely on Suga for such teachings. Accordingly, Taivitie and Suga, whether taken alone or in combination, do not disclose or suggest claim 1.

The Examiner also alleges one would be motivated to combine Taivitie and Suga because doing so "would be to improve the responsibility and reliability of the IC card system by controlling circuits in [a] communication system." See Office Action, page 3. Applicant respectfully submits that such a motivation does not have any bearing on the claimed elements at issue, nor has the Examiner indicated any reasonable expectation of success for making such a combination. In particular, Suga is primarily directed to controlling power transmission and, in that vein, discloses circuitry for regulating power. See Abstract, Fig. 4, for example. There is therefore no motivation for one of skill in the art to make the combination the Examiner has proposed. Applicant respectfully points out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p. 2100-120. By contrast, the required

motivation to combine references must “be found in the prior art, and not based on applicant's disclosure.” See M.P.E.P. § 2143 (emphasis added). For at least the above reasons, the Examiner should withdraw the rejection of claim 1.

New claims 15-18 depend from allowable claim 1. Claims 15-18 include additional recitations that are neither disclosed nor suggested by the cited prior art, and are also allowable at least due to their dependence from allowable claim 1.

Claim 8, as amended, recites a data processing apparatus including, among other things, “a casing having a card slot for inserting therein an IC card” and “a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot.” Taivitie and Suga, taken alone or in combination, do not disclose or suggest at least these features.

In the Examiner's rejection of claim 8, the Examiner alleges Taivitie discloses an antenna incorporated in a casing, citing Fig. 5. However, Applicant's claim 8, as amended, recites a data processing apparatus including at least “a casing having a card slot for inserting therein an IC card.” Fig. 5 of Taivitie discloses that antenna module 40 may be attached to PCMCIA card 50 via antenna socket 51, but does not show “a casing having a card slot for inserting therein an IC card.”

Nor does Suga, which the Examiner applied in the rejection regarding other features, make up for the deficiencies of Taivitie. Accordingly, Taivitie and Suga, whether taken alone or in combination, do not disclose or suggest claim 8. As the Examiner merely incorporated by reference the Examiner's analysis with regard to claim 1 (Office Action, page 4), Applicant again respectfully traverses the Examiner's alleged

motivation to combine Taivitie and Suga, as discussed above. Accordingly, for at least the above reasons, the Examiner should withdraw the rejection of claim 8.

Additionally, neither Taivitie nor Suga disclose or suggest that "the antenna is provided in an eject lever to be operated to eject the IC card from the card slot," as recited in claim 9 or that "the antenna is provided on a surface of the casing," as recited in claim 10. Claims 9 and 10 depend from allowable claim 8 and are also allowable at least due to their dependence from allowable claim 8. Accordingly, the Examiner should also withdraw the rejection of claims 9 and 10.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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